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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1949

No. 730

E. B. KAISER COMPANY,
Petitioner,

v.

THE RIC-WIL COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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IN THE

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OCTOBER TERM, A. D. 1949

No.

E. B. KAISER COMPANY,
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v.

THE RIC-WIL COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The Petitioner, E. B. Kaiser Company, prays that the writ of certiorari issue to the United States Court of Appeals for the Seventh Circuit to review the decree of that Court rendered on January 5, 1950 (R. 389), rehearing denied on March 1, 1950 (R. 390). A transcript of the record in the case, including the proceedings in said Court of Appeals is furnished herewith in compliance with Rule 38 of the Rules of this Court.

Summary and Statement of Matter Involved.

This is a patent infringement suit. The Petitioner was charged with infringement of four patents relating to insulated steam pipe. The District Court held each of the claims in suit of each of the four patents in suit valid and infringed (R. 317). The Court of Appeals affirmed, modifying the judgment of the District Court only as to the form of the judgment and extent of recovery allowable (R. 389).

This is not a case in which courts below concurred in finding significant differences between the prior art and the patents in suit. Neither Court recognized any differences between the prior patent art and the patents in suit. The basis of their concurring findings of validity was their concurring conclusion of law that one sued for patent infringement must establish his defense by *testimony* (R. 315, 382-383, 387). Neither Court analyzed or discussed a single prior art patent and neither Court called attention to any distinction, significant or insignificant, between any prior art patent, and any of the claims in suit of any of the patents in suit (R. 312-316, 377-388).

Since the Patent Statutes themselves provide that one cannot re-patent what is shown in prior patents or prior printed publications (R.S. 4886, 35 U.S.C. 31 set forth in the Appendix, p. 1a) one sued for patent infringement establishes a defense of lack of novelty and lack of invention by offering readily understandable prior United States Letters Patent without any testimony. This has heretofore been the rule applied by this Court and Courts of Appeals for various circuits.

Neither the District Court nor the Court of Appeals made any mention of the Patent Office histories of any of the patents in suit. This is not a case where the Courts below concurred in finding that the patentee had not

shifted his position from that upon the basis of which his patent was granted; nor is it a case in which the Courts below concurred in justifying the patentee's shift of position. It is a case in which both Courts, being unimpressed with the expert witness called by the counsel for the Petitioner in the District Court, felt unobliged to even consider the plain admissions and estoppel of the patentee.

The defense of the Petitioner to each of the patents in suit is based upon prior United States Letters Patent which are publications of the United States Patent Office specifically mentioned by statute as competent defensive evidence and self-proving both as to date and disclosure.

Petitioner further relies upon the Patent Office histories of three of the four patents in suit, which histories are found in certified copies of Patent Office records. Because of what it considered to be a lack of credible testimony, the Court of Appeals paid no heed to the documents relied upon by Petitioner and characterized Petitioner's defense as based "upon argument rather than testimony and proven facts" (R. 384).

The first patent in suit, which may be characterized as the "unit construction patent," is the Gottwald Patent No. 1,991,455 (R. 344). The claims in suit of this patent, claims 11, 14, 15, 16 and 17, are directed to the prefabrication of insulated steam pipe and the use of prefabricated units in a piping system. Broadly stated, the elements of a pipe unit consist of a steam pipe, a layer of insulation, and an outer covering or shell. Although the Patent Office was aware of the prior use of pipes, insulation and covering, it cited no prior art showing the prefabrication of pipe units (R. 280). At the trial of the case the Petitioner offered several patents not considered by the Patent Office, each of which showed that the prefabrication of such units was old (R. 398, 402, 406, 414).

Claim 11 of the "unit construction" patent in suit, No. 1,991,455, as issued, was clearly too broad. The patent owner, rather than disclaiming the claim or, by reissue, asking that it be reexamined and reissued, merely filed a disclaimer disclaiming from the claim certain structures (R. 353). At the same time the patent owner filed no disclaimer as to claim 12, which was subject to the same defects as, and not substantially different from, claim 11 as to which the disclaimer was filed. The Patent Statutes require that when a disclaimer is filed, the part disclaimed shall be "definitely distinguishable" from the part retained (35 U.S.C. 71). This matter was not discussed in the opinion of the Court of Appeals, being dismissed with other defenses not discussed as "without merit" (R. 388).

The second patent in suit, which may be characterized as the "spacer" patent, is Gottwald and McLeish Patent No. 2,050,968 (R. 355) which discloses and claims the use of a circular flat plate with a hole in it in order to space the inner steam pipe from the outer shell. The single claim in suit (claim 2) was allowed by the Patent Office only after it was amended to define the spacing element as "comprising a flat plate" (R. 498, 504-508). In the remarks accompanying the amendment the applicant explained that "the use of a flat *plate* for the spacer was a distinctive characteristic of applicant's invention and lacking from the prior art" (R. 504-505). By the amendment and the argument, the applicant distinguished a three-legged spider which had been cited by the Patent Office. The accused structure of Petitioner is a three-legged spider and not a "flat plate." This Court has repeatedly held that a patentee cannot get his patent by agreeing with the Patent Office on one construction of his claims, and then after the patent issues repudiate this construction and regain what the Patent Office required him to cede as a condition for allowance. The Court of Appeals in its opinion did not discuss this issue.

The third patent in suit, which may be characterized as the "anchor" patent, is the McLeish Reissue Patent No. 22,988 (R. 367) of which claim 1 is in suit. This patent calls for a steel plate to anchor the inner steam pipe to the ground. The plate is welded to the steam pipe and extends through the shell and beyond the shell so that it can be imbedded in concrete. By this means, when the inner steam pipe expands or contracts with changes in temperature, it is anchored to the ground. The prior art included anchors secured to a steam pipe extending through the shell and imbedded in concrete (R. 432, 438). The accused structure does not anchor the steam pipe to the ground but uses merely a plate welded to the inner pipe and bolted to the outer shell (R. 19). The Petitioner's shell is of cast iron so that its steam pipe need not be, and is not, anchored to the ground but is merely anchored to the shell (R. 19, 149-150).

The fourth patent in suit is Gottwald Patent No. 2,378,214 (R. 362), claims 1, 5 and 6 of which are in suit. This patent discloses the use of an insulated U-shaped bend with a shell common to both arms of the U. The idea was to permit expansion and contraction of the pipe by bending at the U. This idea was old.

The prior patented art relied upon as showing invalidity consists entirely of patents not cited by the Patent Office Examiner against the respective claims here involved.

Jurisdiction.

The jurisdiction of this Court arises under Title 28 U.S.C., Sec. 1254. The judgment of the Court of Appeals for the Seventh Circuit, which Petitioner seeks to have reviewed, was entered on January 5, 1950 and rehearing was denied on March 1, 1950 (R. 389 and 390).

The Questions Presented.

1. Whether one charged with patent infringement may show invalidity of the patent by offering prior art patents which disclosed the patented thing without also "establishing its defense by clear and convincing *testimony.*"

2. Whether a patentee can secure allowance by the Patent Office on one construction of his claim and then, in an infringement suit, repudiate that construction.

3. Whether a patent owner filing a statutory disclaimer and thereby admitting invalidity of the claim as issued, can rewrite the claim by disclaimer without risking surrender and reissue, and without disclaiming another claim which is invalid for the same reasons as the one disclaimed.

The Reasons Relied On for the Allowance of the Writ.

The discretionary power of this Court is invoked upon the following grounds:

1. The decision of the Court of Appeals for the Seventh Circuit in holding that a prior art patent cannot invalidate "without clear and convincing *testimony*" is in conflict with the express language of the patent statutes and applicable decisions of this Court;

2. The decision of the Court of Appeals for the Seventh Circuit in determining the issues of validity and infringement without any reference to the basis upon which the patents in suit were granted by the Patent Office is in conflict with applicable decisions of this Court;

3. The decision of the Court of Appeals for the Seventh Circuit in approving the redrafting of a claim by disclaimer and not requiring any disclaimer as to a patentably indistinguishable claim, is in conflict with applicable decisions of this Court.

Wherefore, your Petitioner respectfully prays that the writ of certiorari be issued under the seal of this Court, directed to the United States Court of Appeals for the Seventh Circuit, commanding that Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and of all proceedings in the United States Court of Appeals for the Seventh Circuit, had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the United States Court of Appeals for the Seventh Circuit be reversed, and that Petitioner be granted such other and further relief as may be proper.

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Counsel for Petitioner.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1949

No.

E. B. KAISER COMPANY,
Petitioner,

v.

THE RIC-WIL COMPANY,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I. OPINIONS OF THE COURTS BELOW.

No written opinion was rendered by the District Court. The Findings of Fact and Conclusions of Law filed by the District Court appear in the record on pages 312 to 316, inclusive, and are reported in 81 U.S.P.Q. 6.

The opinion of the Court of Appeals for the Seventh Circuit appears at pages 377 to 388 inclusive and page 390 of the record, and is reported in 179 F. (2d) 401.

II. JURISDICTION.

The jurisdiction of this Court is invoked under Title 28 U.S.C., Sec. 1254. The judgment of the Court of Appeals was entered and opinion filed on January 5, 1950. The opinion was modified and rehearing denied on March 1, 1950.

III. STATEMENT OF THE CASE.

The Petition contains a summary of the facts material to the consideration of the questions presented. Neither the District Court nor the Court of Appeals pointed out any differences between the prior art patents relied upon and the claims of the patents in suit. Both Courts took the view that there was no necessity to analyze any of the prior art patents relied upon because they found the testimony of defendant's expert witness so lacking in credibility as to be of substantially no weight (R. 315, 382-383). The District Court concluded, as a matter of law (R. 315):

> "3. The burden is on the defendant to establish its defense by clear and convincing testimony."

The District Court further incorporated this view in the Judgment itself (R. 318-319):

> "8. That the defendant admitted producing the various infringing structures and based its defense solely on the prior patented art and therefore assumed the burden of establishing its defense by clear and convincing testimony.
>
> "9. That the defense offered consisted solely of the references cited and the uncorroborated testimony of Wilbur Fiske Kellogg who is neither a member of the bar nor a registered professional engineer, and, therefore, is not qualified to testify either as to the legal effect or the engineering aspects of patents, and whose testimony moreover was inconsistent within itself and contradictory to established facts; and that the defendant has therefore totally failed to sustain the burden of proof upon it."

The Court of Appeals quoted the foregoing two paragraphs of the judgment and while it expressed some doubt as to the soundness of the statement in Paragraph 9 that defendant's expert was not qualified, it in all other respects

fully approved the statements and affirmed these paragraphs in the judgment without any modification (R. 382-383). The Court of Appeals joined the District Court in criticizing the testimony of defendant's expert (R. 383) and explained its failure "to analyze and discuss" the prior art as futile "in view of the state of the record". The Court of Appeals said in this regard (R. 384):

> "It would be a useless and well near impossible task to analyze and discuss the numerous prior art patents relied upon to anticipate the various claims of the patents in suit, and in view of the state of the record it would be a futile undertaking for us to so attempt. Especially is this so inasmuch as the sole expert testimony offered by the defendant in explanation of the prior art patents was so lacking in credibility as to carry no substantial weight. Defendant's position in this court, as in the court below, depends upon argument rather than testimony and proven facts. We have carefully considered this argument, especially as it pertains to the prior art patents referred to and discussed in defendant's brief, and we are not persuaded that we would be justified in refusing to accept the findings as made below. In this connection, it seems fair and appropriate to observe that defendant's present counsel did not participate in the trial below and are not responsible for the record before us."

Examples of prior art patents which the District Court and the Court of Appeals found unnecessary "to analyze and discuss" because of lack of *testimony* are discussed in the Argument herein. One illustration will be given here.

Claim 11 of the Gottwald Patent No. 1,991,455 reads as follows (R. 353):

> "An article of manufacture comprising a conduit unit having
> an inner integral fluid conducting tube,

heat-insulating material surrounding said tube nearly to its ends,

and a covering surrounding said heat-insulating material and extending nearly to the ends of said tube."

It is to be observed that this claim calls for a "conduit unit" which has three elements, an inner tube, insulation, and a covering. Of course, the idea of insulating a pipe and covering the insulation was not a new one in 1931 when Gottwald filed his application. The alleged novelty in this claim was stated by the applicant, when the claim was presented to the Patent Office as residing in the idea of a "conduit unit". In submitting the claim the applicant said (R. 497):

> "• • • This, however, is just what applicant has accomplished, and the real essence of his invention is the provision of a unit which is a single fabricated article of manufacture. This can be manufactured as contradistinguished from being built, at any desired place, such as in a shop remote from the installation. It has only to be brought to the site of its installation, put in place, and connected to other units to be in servicable condition. • • •"

The Patent Office had cited no reference showing a unitary structure (R. 280). Therefore, this claim was allowed on the theory that Gottwald was the first to conceive of the idea of prefabricating lengths of insulated steam pipe. One of several relevant prior art patents not considered by the Patent Office was Ashcroft 235,846 (R. 398). The Ashcroft patent was entitled "covering for steam pipes" (R. 399). Figure 1 of his patent is reproduced here.

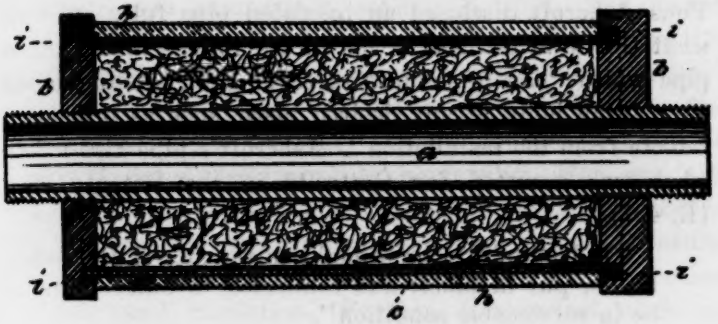


Fig. 1.

Ashcroft described his structure generally as follows (R. 399):

> "The invention consists in covering the pipes with animal hair or other analogous substance and securing the same within a protecting casing provided with coupling flanges, as hereinafter particularly described."

From the illustration and the description, the pipe or tube *a*, the insulation *d*, and casing or covering *c* are readily apparent. Thus Ashcroft showed each of the elements of claim 11 of the Gottwald patent. It is to be further observed that Ashcroft even showed the details of the claim—insulating material and covering not extending the full length of the pipe or tube, but extending nearly to the ends.

Ashcroft also disclosed the idea of prefabricating the insulated pipe in section. His specification states (R. 399):

> "The construction and the method of connecting the respective parts together, as shown, will enable the manufacturer to cover and complete each length of pipe so that it may be transported ready for laying".

Thus Ashcroft disclosed an insulated pipe fully meeting what Gottwald claimed as his in the Patent Office, *i.e.*, a pipe which "can be manufactured as contradistinguished from being built, at any desired place, such as in a shop remote from the installation". Ashcroft's pipe also meets what was asserted for Gottwald in the Patent Office (R. 497):

> "It has only to be brought to the site of its installation, put in place, and connected to other units to be in serviceable condition".

One of the findings of the District Court was (R. 312):

> "3. Prior to February 27, 1931, the filing date of the application on which letters patent No. 1,991,455 issued, no conduit systems had been built of prefabricated units, each unit consisting of an inner pipe, a covering load-sustaining shell and heat insulating material."

This finding was quoted by the Court of Appeals and specifically approved (R. 385, 387). Read literally the finding has some support in the record since it recites merely that no conduit systems "had been built" of pre-fabricated units. The District Court and the Court of Appeals held that it was unnecessary to analyze the Ashcroft disclosures since it was merely a prior art patent and there was no evidence that it "had been built".

Other patents, likewise showing all of the substance of the first patent in suit were, like Ashcroft, passed over by both the District Court and the Court of Appeals without analysis because there was no *testimony* believed by the courts to be credible with respect to them. These are mentioned in the argument hereinafter.

After Gottwald Patent No. 1,991,455 issued, the Respondent filed a disclaimer as to claim 11, purporting to disclaim from the claim any unit in which the central tube and

covering are hermetically sealed (R. 353). The reason assigned for the disclaimer in the courts below was "to prevent confusion with some thermos-bottle-like device". No showing was made by Respondent as to how the disclaimer could inject validity into a claim conceded (by the fact of filing disclaimer) to be invalid. Nor was any showing made by Respondent as to why the claim, admitted to be invalid if read on a device using vacuum as insulation, could involve invention by providing for some other conventional insulation. Further, Respondent made no showing as to how claim 12, also on a conduit unit having a pipe, insulating material, and a shell, patentably differed from claim 11 before disclaimer. No disclaimer was filed as to claim 12.

The issues with respect to the other three patents in suit are the same as with the first patent in suit, save that no disclaimer question is involved. In each instance the District Court and the Court of Appeals found validity without analysis of the prior art. The basis was the lack of *testimony*. There is some ambiguity in the record as to what *testimony* the District Court and the Court of Appeals found wanting. The findings of the District Court as to this were Findings 29 to 35 (R. 315). These findings indicate that the District Court desired testimony of someone having personal knowledge of the prior art devices, and also desired expert testimony. The Court of Appeals apparently also desired some expert testimony and characterized Petitioner's defense as depending "upon argument rather than *testimony* and proven facts". (R. 384). In its original opinion, the Court of Appeals stated that the defendant had to prove that prior art patents were operable (R. 381). This is the only specific statement as to what testimony that Court found wanting. After consideration of Petition for Rehearing, which pointed out that

the cases did not support the burden which the Court of Appeals had placed upon the Petitioner, the Court of Appeals eliminated from its opinion the sentences which required proof of actual use of the prior art (R. 381, 390).

IV. SPECIFICATION OF ERRORS.

1. The Court of Appeals erred in holding a patent cannot be invalidated by self proving prior art itself, unsupported by testimony.

2. The Court of Appeals erred in construing patent claims without reference to the construction placed upon the claims by the applicant and the Patent Office when the patent was allowed.

3. The Court of Appeals erred in approving the redrafting of a claim by disclaimer and in not requiring that the subject matter disclaimed be patentably distinct from subject matter retained.

V. ARGUMENT.

Each of the Four Patents In Suit Is Invalid Over Prior Art Patents and No Testimony Should Be Required.

The First Patent in Suit

The failure of the Court of Appeals to discuss, or even "analyze" any prior art patents "in view of the state of the record" has been discussed above. The Court not only considered it unnecessary to analyze the prior art, but stated that this would be a futility since *testimony* was lacking (R. 384). In thus declining to look at a prior art patent unless accompanied by convincing *testimony*, the Court of Appeals announced and applied a rule contrary to many decisions of this Court and other courts, and contrary to the Patent Act itself. In so ruling, the Court of Appeals thoroughly confused a prior patent with a prior public use, as to which convincing testimony may be required in order to establish what the prior use was, and when it took place. When there is a prior grant of a United States Letters Patent, there is no question as to the date of the disclosure and there can be no debate as to what the disclosure is. Although expert *testimony* may at times be of assistance in clarifying otherwise complex facts, it is not essential. When such expert *testimony* is available, it is the disclosure of the prior art patent itself, as published by the Patent Office, that is the evidence establishing invalidity.

In the Statement of the Case, claim 11 of the first patent in suit, Gottwald No. 1,991,455, is set forth, together with one of several prior art patents which show each of the elements called for in the claim. The Court of Appeals

sustained that claim, which, in short, is for a pre-fabricated insulated pipe unit consisting of a steam pipe, insulation, and covering over the insulation. The Ashcroft patent, which was published 50 years before Gottwald applied for his patent, showed everything claimed, responding literally and in substance. (See pages 11 to 14 herein).

Another prior art patent showing the substance of the claim is Trucano, No. 1,140,663 (R. 402). Trucano used vacuum for insulation so that his structure was specifically excluded by the disclaimer. However, Trucano fully disclosed the idea of pre-fabricating sections of insulated pipe. He stated (R. 403):

> "Therefore, it is possible to vacuumize the insulation in the process of manufacture of insulated pipes, leaving only the joints or couplings to be insulated at the time of installing the pipe".

Another patent also showing each of the elements of a center pipe, insulation, and a covering and calling attention to the possibility of pre-fabrication is Durant No. 1,709,844 (R. 406). Durant pointed out that the insulating and covering of the pipe might be done either at the factory or in the field. He stated (R. 410):

> "The sections of pipe may be insulated at the factory and transported without injury to the point of use, or the insulating work may be as easily carried out at the trench in which the pipe is to be laid."

Still another prior art patent showing the same elements in a pipe section or unit is Bartlett No. 417,768 (R. 414).

The Court of Appeals held the Gottwald Patent No. 1,991,455 valid over each of the prior art patents discussed above without analyzing any of the prior art patents. The Court of Appeals stated as to the Gottwald patent (R. 380):

> "Here for the first time was a unit which could be completed indoors, affording workers protection in all

kinds of weather and thus increasing their efficiency, and insuring a better quality product".

In support of this statement, the Court of Appeals pointed out no distinction between the patent in suit and any of the four prior art patents discussed above. There are no distinctions. Each of those prior art patents showed precisely what the Court of Appeals stated was shown in Gottwald "for the first time". The only justification found in the opinion of the Court of Appeals is that that Court believed it was not required to look at the prior art patents and consider them because of the absence of testimony.

The error in the Court of Appeals decision appears first in the Patent Statutes themselves. Congress has stated who shall be entitled to a patent. The statute provides that

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country * * * may * * * obtain a patent therefor" (R.S. 4886, 35 U.S.C. 31, quoted in full, Appendix, p. 1a).

One is not entitled to a patent if the alleged invention has previously been patented or described in a printed publication. The United States patents of the prior art referred to above fall within the provisions of the Act and by themselves, without any testimony, constitute a statutory bar both as patents and as printed publications.

By statute, the applicant for a patent must take an oath that he does not believe that his alleged invention "was ever before known or used" (R.S. 4892, 35 U.S.C. 35, quoted in full in Appendix, p. 1a).

By statute one of the defenses which an alleged infringer may prove on trial is that the alleged invention "has been patented or described in some printed publication" prior to the alleged invention (R.S. 4920, 35 U.S.C. 69, quoted in full in Appendix, p. 2a).

Proof of a prior art patent is *per se* proof of the prior patenting and prior printed publication of the contents of that patent. Where, as in the instant case, the alleged invention is simple, there is no necessity for any testimony. Indeed, even if testimony be received, the disclosure of the prior art patent itself, and not the *testimony*, is the invalidating evidence.

Kohn v. *Eimer, et al.*, 265 Fed. 900 (C.C.A. 2, 1920).

This Court has many times held that a patent may be invalidated without the necessity for any testimony whatsoever. For example, in *Mast-Foos & Co.* v. *Stover Mfg. Co.*, 177 U. S. 485, 44 L. Ed. 856 (1900), this Court held a patent on a windmill invalid on appeal from a preliminary injunction. No testimony whatever had been taken in the case. An answer had not yet been filed. The patent in suit in that case was held invalid over prior patents and over a prior use. The date and identity of the prior use were shown by affidavits. There being no doubt as to the existence or date of the anticipating devices (See 177 U.S. 495), the Court held the patent invalid. Likewise, in the case at bar, there is no doubt as to the existence or date of any of the prior art patents. They were self proving on their faces. The only issue submitted for adjudication is the significance or applicability of the prior art. No *testimony* is required as to this.

This Court has frequently held patents invalid on demurrer where there was no testimony or evidence of any

kind. See for example *Risdon I. & Locomotive Works* v. *Madart,* 158 U. S. 68, 39 L. Ed. 899 (1895), and *Richards* v. *Chase Elevator Co.,* 158 U. S. 299, 39 L. Ed. 991 (1895). Another instance in which this Court has held a patent invalid on its face over prior art of which the Court could take judicial notice without any testimony is *Brown* v. *Piper,* 91 U. S. 37, 23 L. Ed. 200 (1875). The Courts of Appeals in various circuits have likewise frequently held patents invalid for want of invention or want of novelty on demurrer.

Friend, et al. v. *Burnham & Morrill Co.,* 55 F. (2d) 150, (C.C.A. 1, 1932).

Kuhn, et al. v. *Lock-Stub Check Co.,* 165 Fed. 445, (C.C.A. 2, 1908).

Strom Mfg. Co. v. *Weir Frog Co.,* 83 Fed. 170, (C.C.A. 6, 1897).

Thomas, et al. v. *St. Louis & S. F. R. Co.,* 149 Fed. 753 (C.C.A. 6, 1907).

Charles Boldt Co. v. *Nivision-Weiskopf Co.,* 194 Fed. 871 (C.C.A. 6, 1912).

Gray v. *Texas Co.,* 75 F. (2d) 606, (C.C.A. 8, 1935).

Towne Steering Wheel Co. v. *Lee,* 199 Fed. 777 (C.C.A. 9, 1912).

Moreover, Courts of Appeal in circuits other than the Seventh Circuit have recognized that testimony is not essential to invalidate over the prior art.

Kohn v. *Eimer, et al.,* 265 Fed. 900 (C.C.A. 2, 1920).

Fried, Krupp Aktien-Gesellschaft v. *Midvale Steel Co.,* 191 Fed. 588 (C.C.A. 3, 1911).

The ineffectiveness of the so-called expert testimony offered by a witness called by defendant's counsel in the District Court should not have blinded the courts below to

the unalterable facts, unassailably proved by the published prior art patents. Likewise whatever testimony there may or may not have been in the record can in no way change the Patent Office histories of the patents in suit and the solemn agreements upon the basis of which the patents in suit were granted. The evidence, consisting of prior art patents is plain, convincing, and conclusive, without testimony or with testimony, either sound or unsound, credible or incredible. No witness or potential witness could change the unalterable, or by verbal fulminations, excusable or inexcusable, effect the repeal of the Patent Statutes. The decision of the courts below declining to analyze or consider the prior art patents for want of testimony, is contrary to the Patent Statutes themselves, to many decisions of this Court, and to many decisions of other Courts of Appeals.

The Second Patent in Suit

The second patent in suit is Gottwald & McLeish Patent No. 2,050,968 (R. 355). The alleged invention is a plate with a hole in its center through which the inner pipe passes. The purpose of the plate is to space the inner pipe from the outer pipe. The Court of Appeals failed to look at prior art patents showing various spacing means because of the lack of testimony. Examples of the prior art which the Court of Appeals failed to examine on the grounds that it would be "futile" without testimony are discussed herein at pages 28 to 31 where reference is made to the failure of the Court to give any heed to the construction placed upon this patent when it was granted by the Patent Office.

The Third Patent in Suit

The third patent in suit is McLeish Reissue No. 22,988 (R. 367). Only claim 1 of this patent is in suit. This claim is on a plate secured to the inner steam pipe and projecting through the outer casing a substantial distance in order to anchor the inner pipe to the ground (R. 370).*

As to this patent the District Court found (R. 314) and the Court of Appeals quoted with approval (R. 386):

> "20. Patent No. Re. 22,988, is directed to an anchor consisting of a plate secured to an inner pipe and passing through a surrounding shell or covering to transmit axial forces to the ground.

*1. An underground conduit securing means comprising a perforated plate through the perforation of which a pipe extends, the plate being permanently and unitarily fixed to the exterior of the pipe, a casing consisting of two parts surrounding the pipe, and abutting opposite sides of the plate, sealing means connecting the parts of the casing to the sides of the plate, the plate extending substantially beyond the periphery of the casing to transmit pressure to the ground.

"21. None of the claims of patent No. Re. 22,988 are limited to the shape of the plate.

"22. None of the claims of patent No. Re. 22,988 are limited to preclude flanges or other material overlying parts of the surface of the plate."

In finding this patent valid, neither Court analyzed the Steffens Patent No. 1,227,087 (R. 432) believing such analysis unnecessary and "futile" without testimony. No testimony is required to show the significance and controlling importance of Steffens' disclosure which includes the following (R. 433):

"Anchors 8 may be rigidly attached to the pipe at proper points and surrounded by solid blocks of concrete. In such case, the insulating cover 2 and its protective shells 3 and 4 are made to approach the anchor 8 closely at each side, and the unavoidable spaces therebetween are filled with insulating material 8′ similar to that of the covering 2, preferably 85% magnesium cement. The concrete 8″ is then filled around the anchor and adjacent parts of the covering."

Another patent showing an anchoring plate is Gysling Patent No. 1,931,465 (R. 438). A portion of its disclosure reads (R. 445):

"As above stated, a suitable number of expansion joints of any well-known construction will be inserted at intervals in the length of the pipe. It is, of course, essential that the expansion of the pipe line should be equally distributed to these expansion joints and for this purpose I have provided an anchoring ring designated, generally, by the reference character 33 and which is illustrated in detail in Figs. 10 and 11. The purpose of the anchoring ring is to secure the pipe line to the conduit. As will be clear from an inspection of Fig. 10, the anchoring ring 33 comprises two sections 34 and 35, which are secured together by means of bolts 36. The sections of the anchoring ring are provided with a machined flange 37 which, as will

be seen from an inspection of Fig. 11 is clamped between the flanges 2,2 of adjacent sections of the conduit and securely held in place by means of the bolts 10. Thus, the pipe 18 is anchored to the conduit and, at this point, as is shown in Fig. 1, the conduit is embedded in the reinforced concrete block 13. It will be understood that the anchoring rings are located approximately midway between expansion joints of the pipe line, and it will be apparent from the construction described that the expansion of the pipe line will be equally distributed to the joints on either side of the anchoring ring."

Neither the District Court nor the Court of Appeals pointed out any distinctions whatsoever between either of the two prior art patents and the McLeish claim. No significant differences exist. Validity was found only by treating analysis of the prior art disclosures as unnecessary and futile without *testimony*.

The Fourth Patent in Suit

The fourth patent in suit is Gottwald No. 2,378,214 (R. 362). Claims 1, 5 and 6 are in suit. This patent is on the use of a U-bend of insulated pipe to permit adjacent lengths of steam pipe to expand or contract relative to each other. Figure 3 of the Gottwald patent in suit is here reproduced together with Figure 24 of the prior art Osborne Patent No. 236,247 (R. 448) which issued in 1881, and Figure 16 of the prior art Gottwald and McLeish Patent No. 2,330,966 (R. 484), application for which was filed in 1939.

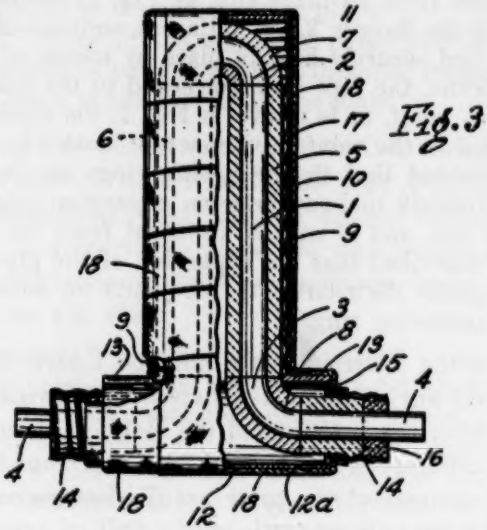


Fig. 3

Gottwald Patent in Suit No. 2,378,214

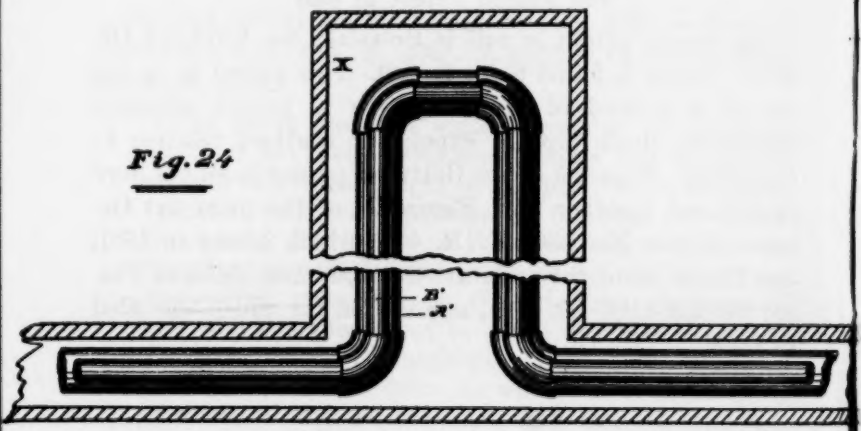


Fig. 24

Osborne Prior Art Patent No. 236,247

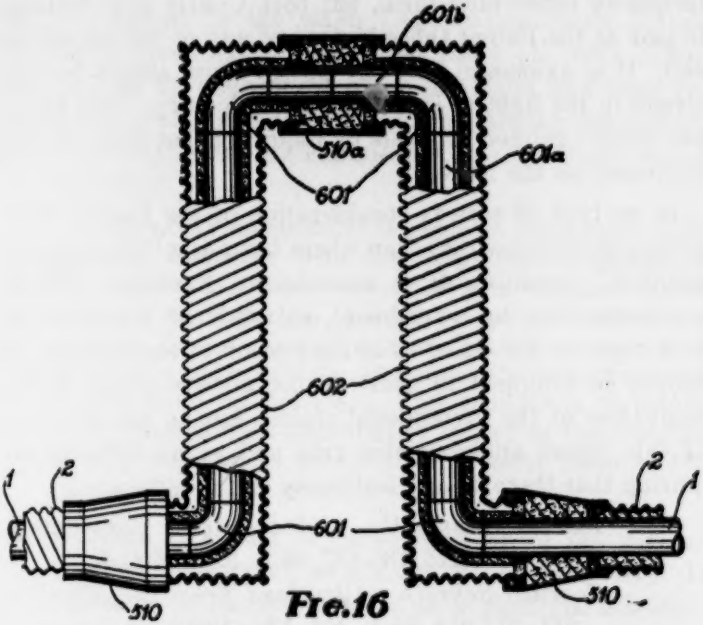


Fig. 16

Gottwald & McLeish Prior Art Patent No. 2,330,966

It will be readily observed that the structure of the patent in suit is identical with the prior Gottwald and McLeish patent save for the use of the T-shaped casing of the Osborne device instead of the U-shaped outer casing of the prior Gottwald and McLeish patent. Neither the District Court nor the Court of Appeals heeded either of the prior art patents to find that any patentable advance had been made over them. Patentability was found only by declining to look at the prior art for want of *testimony*.

A Patent Owner Should Be Bound by the Construction of His Claims Agreed Upon by the Applicant and the Patent Office When the Patent Issued.

The District Court and the Court of Appeals, not only declined to examine prior art patents because of lack of

testimony concerning them, but both Courts also declined to look at the Patent Office history of any of the patents in suit. It is axiomatic that any patent claim should be construed in the light of its Patent Office history. This Court has never qualified this rule by requiring that there be any testimony on the issue.

In no type of case is consideration of the Patent Office history more important than where there is a "file wrapper estoppel" resulting from amendment of claims. Where a patentee has, by amendment, surrendered his assertion of a right to the claim as it read prior to amendment, he should be estopped to construe the allowed claim as the equivalent of the surrendered claim. Among the decisions of this Court applying this rule and in no instance requiring that there be any testimony on the issue are:

Exhibit Supply Co. v. *Ace Patents Corporation,* 315 U. S. 126, 136-137, 86 L. Ed. 736 (1942).

Schriber-Schroth v. *Cleveland Trust Co.,* 311 U. S. 211, 217-218, 85 L. Ed. 132 (1940).

Keystone Driller Co. v. *Northwest Engineering Corp.,* 294 U. S. 42, 46-49, 79 L. Ed. 747 (1935).

Smith v. *Magic City Kennel Club,* 282 U. S. 784, 789-790, 75 L. Ed. 707 (1931).

I.T.S. Rubber Co. v. *Essex Rubber Co.,* 272 U. S. 429, 443-445, 71 L. Ed. 335 (1926).

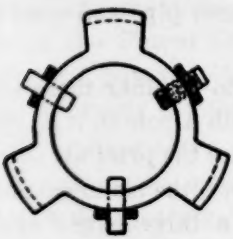
Claim 2 of the second patent in suit, Gottwald and McLeish Patent No. 2,050,968 reads as follows:

> "A conduit system comprising a fluid conducting pipe, a casing surrounding and spaced from said pipe, and a guide **comprising a flat plate** interposed between said pipe and said casing and extending substantially the entire distance from the pipe to the casing above and at both sides of the pipe."

The words in bold face type "comprising a flat plate" did not appear in the claim (Application claim 19) as originally presented to the Patent Office (R. 498). They were added by amendment after the claim had been rejected (R. 504). In the remarks accompanying the amendment and explaining its significance, the applicant stated (R. 504-505):

> "The above amendment is made in accordance with a recent interview with the Examiner in charge of this application, and incorporates a thought which was for the first time brought out at said interview, namely: that the use of a *plate* for the spacer was a distinctive characteristic of applicants' invention and lacking from the prior art. This thought is therefore being incorporated immediately in two of the rejected claims, which it is believed will render them allowable." (Emphasis ours).

The guide or spacer is shown, in each of the various modifications illustrated, as a flat plate (R. 355, 357). It is referred to in the specification as a plate (R. 359-360). Thus it is clear that by the language "comprising a flat plate" both the applicant and the Patent Office understood that a disc-like or plate-like spacing member was intended. The accused spacer and a prior art spacer of Elkin Patent No. 1,041,256 (R. 418) are here reproduced.



Accused Spacer

Prior Art Spacer

Elkin was a Patent Office reference. It is to be observed that the accused structure closely resembles the prior art and is distinctly different from the structure disclosed and claimed by Gottwald. Both the accused structure and the prior art are three-legged spiders secured to the inner pipe with the legs frictionally engaging the outer pipe. The Gottwald spacer, on the other hand, is a flat plate with anti-friction means. The amendment to claim 2 (the only claim in suit) specifically limiting that claim to a guide "comprising a flat plate", was a recognition of the difference. By the amendment, applicant recognized and emphasized the difference between the claim as rejected and the claim as amended. By the amendment, the applicant abandoned all that is embraced in that difference. *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136, 86 L. Ed. 736 (1942).

Although the opinion of the Court of Appeals by inference suggests that there was some commercial success of this patent (R. 382) there was no showing that its structure was ever used anywhere by anyone. Under these circumstances, it is difficult to see how there could be any basis for finding invention. Moreover, since spacing means were old, Gottwald and McLeish, even if they had patentably improved the spacer, were not entitled to re-patent the old combination of inner pipe, outer pipe and spacer as they endeavored to do in claim 2.*

Whatever view one may take as to whether there could be invention in using a flat plate with a hole in it to space an inner pipe from an outer pipe, since the prior art showed a three-legged spider for this purpose, the claim cannot be valid over, and yet infringed by, a three-legged spider.

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*See **Lincoln Engineering Co. v. Stewart-Warner Corp.**, 303 U. S. 545, 82 L. Ed. 1008 (1938); **Bassick Mfg. Co. v. Hollingshead**, 298 U. S. 415, 80 L. Ed. 1251 (1936).

Moreover, when the patentee and the Patent Office recognized and emphasized the difference between the Gottwald and McLeish disclosure and a three-legged spider, by the use of the words "comprising a flat plate," the claim cannot be infringed by a three-legged spider.

The District Court found (R. 313) and the Court of Appeals quoted with approval (R. 386) the following:

> "12. Letters patent No. 2,050,968 are the first disclosure of a spacer axially movable in a conduit shell and holding a pipe therein against motion toward the top or sides of the shell."

This finding demonstrates two errors by each of the Courts below. In the first place, the Courts treated the spacer patent as being on the broad invention of any spacer, when the Patent Office history shows it was at most a narrow patent on a *plate* as a spacer (R. 498, 504-505). In the second place, the finding is clearly disproved by either the Elkin patent (R. 418) or the Aylsworth patent (R. 428), each of which, long prior to the patent in suit, shows "a spacer axially movable in a conduit shell and holding a pipe therein against motion toward the top or sides of the shell." Both Courts below found patent 2,050,968 to be the first disclosure of a certain spacer only because each considered that a want of testimony foreclosed consideration of the patentee's admission and estoppel in the Patent Office and foreclosed consideration of prior art patents which, as reliable public documents, incontrovertibly establish that such spacers were old.

The Patent Office history of the first patent in suit on a prefabricated insulated pipe unit (Gottwald 1,991,455) is also illuminating but was not consulted by the District Court or the Court of Appeals. Before the Patent Office it was urged that the essence of the invention was the provision of a prefabricated unit (R. 496-497). In the Patent

Office no prior patent was cited indicating that the idea of prefabricating an insulated pipe had ever been known (R. 280). Thus it is clear that the Patent Office allowed the claims of that patent on the assumption that Gottwald was the first to prefabricate a section of insulated pipe. Prefabrication of many different types of construction units was well known in 1931 and the Patent Office erred in granting the patent even on its erroneous assumption. However, the fact that that assumption was made emphasized the importance of the disclosure of prefabrication of insulated pipe in several old patents. Thus the District Court and the Court of Appeals failed to heed the clear indication of the controlling importance of the prior published disclosures in United States patents such as that of Ashcroft No. 235,846 in 1880 (R. 398):

> "The construction and the method of connecting the respective parts together, as shown, will enable the manufacturer to cover and complete each length of pipe, so that it may be transported ready for laying."

The Patent Office history of the fourth patent in suit, Gottwald Patent No. 2,378,214, likewise emphasizes the importance of the prior art patents which the District Court and Court of Appeals declined to consider. The Patent Office allowed the claims only after extended argument urging that the contribution of the applicant was providing straight tubular arms for the U-shaped bends, it being asserted that straight sides or arms would be more flexible than curved arms (R. 510-511). Thus particular significance should have been placed by the District Court and the Court of Appeals upon the disclosure of prior art patents showing that such straight sides were old (see pages 25 to 27 herein).

The many decisions of this Court holding that a patent owner is bound by his conduct in the Patent Office make no requirement that the defendant offer testimony on the

matter. What happened in the Patent Office is a matter of public record which can be proved, and was proved in the case at bar, by certified copies of the record. A Court can read the document with equal facility and understanding—and with more propriety—than any witness. The Courts below, in declining to read and in characterizing as mere "argument" the reading by counsel (R. 384), seriously erred. The result of this error, coupled with the failure of the Courts to consider prior art patents, was the wholesale sustaining of ten claims found in four different patents. This was done without any analysis of prior art patents, the importance of which is clear on their face and emphasized by the Patent Office proceedings.

The First Patent in Suit is Invalid by Reason of an Improper Disclaimer.

All claims of Gottwald Patent No. 1,991,455 are invalid under the disclaimer statute. Claim 11 of the Gottwald Patent No. 1,991,455 (R. 353) as pointed out above, pages 11 and 12 is on a conduit unit having an inner pipe, insulating material, and a covering surrounding the insulating material. Gottwald and the Respondent, as assignee, filed a disclaimer disclaiming from this claim any unit having an hermetically sealed jacket (R. 353). This disclaimer was stated to be in compliance with R.S. 4917, 35 U.S.C. 65, which provides that when, through inadvertence, accident or mistake, a patentee has claimed more than that of which he was the original or first inventor, the patent shall be valid for the part retained, providing the part improperly included in the patent be disclaimed (see Statute set forth in Appendix on page 2a). By filing the disclaimer, Respondent asserted that a conduit unit having an inner pipe, a covering and hermetically sealed insulation, was not the invention of Gottwald. *Marconi Wireless Co.* v. *United States,* 320 U. S. 1, 59, 87 L. Ed. 1731 (1943). Thus patentability of the claim, subsequent to the dis-

claimer, rests upon the disclosure by Gottwald of an insulating material in his conduit unit as distinguished from the use of vacuum or dead air as insulation in the conduit units disclaimed. The question of whether this distinction is a patentable one and one which would sustain a claim was not passed upon by the Patent Office. This Court has condemned such substantial changes in claims by disclaimer. If a patentee desires to amend a claim in a manner so that patentability will be predicated upon a basis different from that originally considered by the Patent Office, such amendment should be sought by reissue. In *Milcor Steel Co.* v. *Fuller Co.*, 316 U. S. 143, 148, 86 L. Ed. 1332 (1942), this Court in its opinion by Mr. Justice Black said:

> "If an alteration of one of the essential elements of a claimed combination were permissible at all, it would be under the reissue statute, Rev. Stat. Sec. 4916, 35 U.S.C. Sec. 64, which grants rights only from the date of reissue and after consideration by the patent office. *Altoona Theatres* v. *Tri-Ergon Corp., supra,* 491. To permit such substantial alterations under the disclaimer statute, which, where applicable, gives effect to the revised claims from the date of the original issue without any consideration by the patent office would be contrary to the policy of the patent laws."

There is a further defect in the disclaimer filed by Respondent. By R.S. 4922 (35 U.S.C. 71, quoted on page 3a of the Appendix), suit may be maintained on a patent after disclaimer if the portion of the original patent retained "is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right." This Court has construed the statute to mean that the portion of the patent retained must be definitely distinguishable from that disclaimed in operation or result. *Maytag Co.* v. *Hurley Machine Co.*,

307 U. S. 243, 83 L. Ed. 1264 (1939). The Respondent failed to comply with this Statute in two respects. In the first place, there is no difference whatsoever in so far as the idea of a unit is concerned, or in so far as the combination of an inner pipe, insulation and an outer covering is concerned, whether the insulation be hermetically sealed, which was disclaimed from claim 11, or whether the insulation not be hermetically sealed as claim 11 purports to read after disclaimer. In other words, what was retained in claim 11 is not "definitely distinguishable from the parts claimed without right" and disclaimed.

Moreover, claim 12, as to which no disclaimer was filed, describes the same article of manufacture described in claim 11 except that claim 12 requires that there be "an outer cylindrical corrugated shell." Gottwald, the patentee, admitted that "the cylindrical corrugated shell" was not his invention but was supplied by the American Rolling Mills Company (R. 69). The Court of Appeals specifically referred to this testimony (R. 379-380). Claims 11 and 12 are reproduced below with the same numerals applied to the same elements:

Claim 11

(1) An article of manufacture comprising a conduit unit having an inner integral fluid conducting tube,

(2) heat insulating material surrounding said tube nearly to its ends,

(3) and a covering surrounding said heat insulating material and extending nearly to the ends of said tube.

Claim 12

(1) An article of manufacture comprising a conduit unit having an inner fluid conducting tube,

(3) an outer cylindrical corrugated shell,

(2) and heat insulating material between the tube and shell, the heat insulating material and shell being slightly shorter than the fluid conducting tube.

These claims describe but a single structure. Even though claim 12 is limited to a corrugated shell, it is in substance the same as claim 11. If claim 11, prior to disclaimer, was too broad in reading upon a prior hermetically sealed conduit unit, as was conceded by the filing of the disclaimer, then claim 12 was clearly invalid for the same reason. The limitation to the corrugated shell developed by someone else, and not Gottwald, does not impart patentability.

The necessity for filing the disclaimer as to claim 11 in 1935, which was conceded and, indeed, asserted by the Respondent, likewise existed as to claim 12. The Respondent having delayed for 15 years to file a comparable disclaimer as to claim 12, all claims of the patent are void. *Maytag Co.* v. *Hurley Machine Co.*, 307 U. S. 243, 83 L. Ed. 1264 (1939).

The Court of Appeals, in its opinion, did not refer to the Gottwald disclaimer. The Petitioner's point that the re-writing of a patent claim by a disclaimer of the type here employed, rather than seeking reissue and submitting the matter to the Patent Office scrutiny, and the Petitioner's point that claims 11 and 12 are not definitely distinguishable, are disposed of in the opinion of the Court of Appeals in the catchall sentence (R. 388):

> "Other questions raised by the defendant are, we think, without merit and need not be stated or discussed."

The Petitioner submits that this cursory treatment by the Court of Appeals constitutes error. When a claim has been materially altered by disclaimer, and the Patent Office has been given no opportunity to pass upon it, a Court should subject the amendment to most careful scrutiny. The presumption of validity which attaches to the grant of the patent, and with which the Court of Appeals

was impressed (R. 381) does not attach to a claim which has been altered by disclaimer. The Court of Appeals erred in failing to give consideration to the disclaimer and to the principles upon which Petitioner relies, which have been frequently applied by this Court.

Vance v. *Campbell,* 1 Bl. (66 U. S.) 427, 17 L. Ed. 168 (1862).

Hailes v. *Albany Stove Co.,* 123 U. S. 582, 31 L. Ed. 284 (1887).

Ensten v. *Simon Ascher & Co.,* 282 U. S. 445, 75 L. Ed. 453 (1931).

Altoona Theatres, Inc. v. *Tri-Ergon Corp., et al.,* 294 U. S. 477, 79 L. Ed. 1005 (1935).

Maytag Co. v. *Hurley Machine Co., et al.,* 307 U. S. 243, 83 L. Ed. 1264 (1939).

Milcor Steel Co. v. *Fuller,* 316 U. S. 143, 86 L. Ed. 1332 (1942).

Marconi Wireless Co. v. *United States,* 320 U. S. 1, 87 L. Ed. 1731 (1943).

CONCLUSION.

The District Court and the Court of Appeals found valid and infringed every claim in suit of every patent in suit by disregarding anticipating prior art patents and without consideration of the Patent Office history of any patent in suit. The assigned reason was that neither Court was impressed with an expert witness called by the defendant. In so doing the Courts erased the plain language of the Patent Statute and repeated decisions by this Court that a prior patent or printed publication can *per se* invalidate without the necessity for any testimony whatsoever.

The Court of Appeals sustained the first patent in suit without consideration of the disclaimer filed by Respondent. The result is that Respondent has been successful in avoiding any scrutiny of its amendment of the claim *either* by the Patent Office or by a Court. Public policy requires that every claim before an adjudication of validity and infringement be scrutinized by *both* the Patent Office and a Court.

It is respectfully submitted that this Court should exercise its discretionary power and issue the writ of certiorari as prayed in the Petition.

Respectfully submitted,

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APPENDIX.

R.S. 4886, 35 U.S.C. 31:

"31. *Inventions patentable*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

R.S. 4892, 35 U.S.C. 35:

"35. *Same; oath of applicant*

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, or consul, holding commission under the Government of the United States, or before any notary

public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States."

R.S. 4917, 35 U.S.C. 65:

"65. *Disclaimer*

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it."

R.S. 4920, 35 U.S.C. 69:

"69. *Pleading and proof in actions for infringement*

In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee

in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third: That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

Fourth: That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect."

R.S. 4922, 35 U.S.C. 71:

"71. *Suit for infringement where specification too broad*

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his

specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

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MAY 3 1950

In the Supreme Court of the United States

OCTOBER TERM, A. D. 1949.

No. 730.

E. B. KAISER COMPANY,
Petitioner,
v.
THE KIC-WIL COMPANY,
Respondent.

BRIEF OF RESPONDENT
In Opposition to Petition for Writ of Certiorari.

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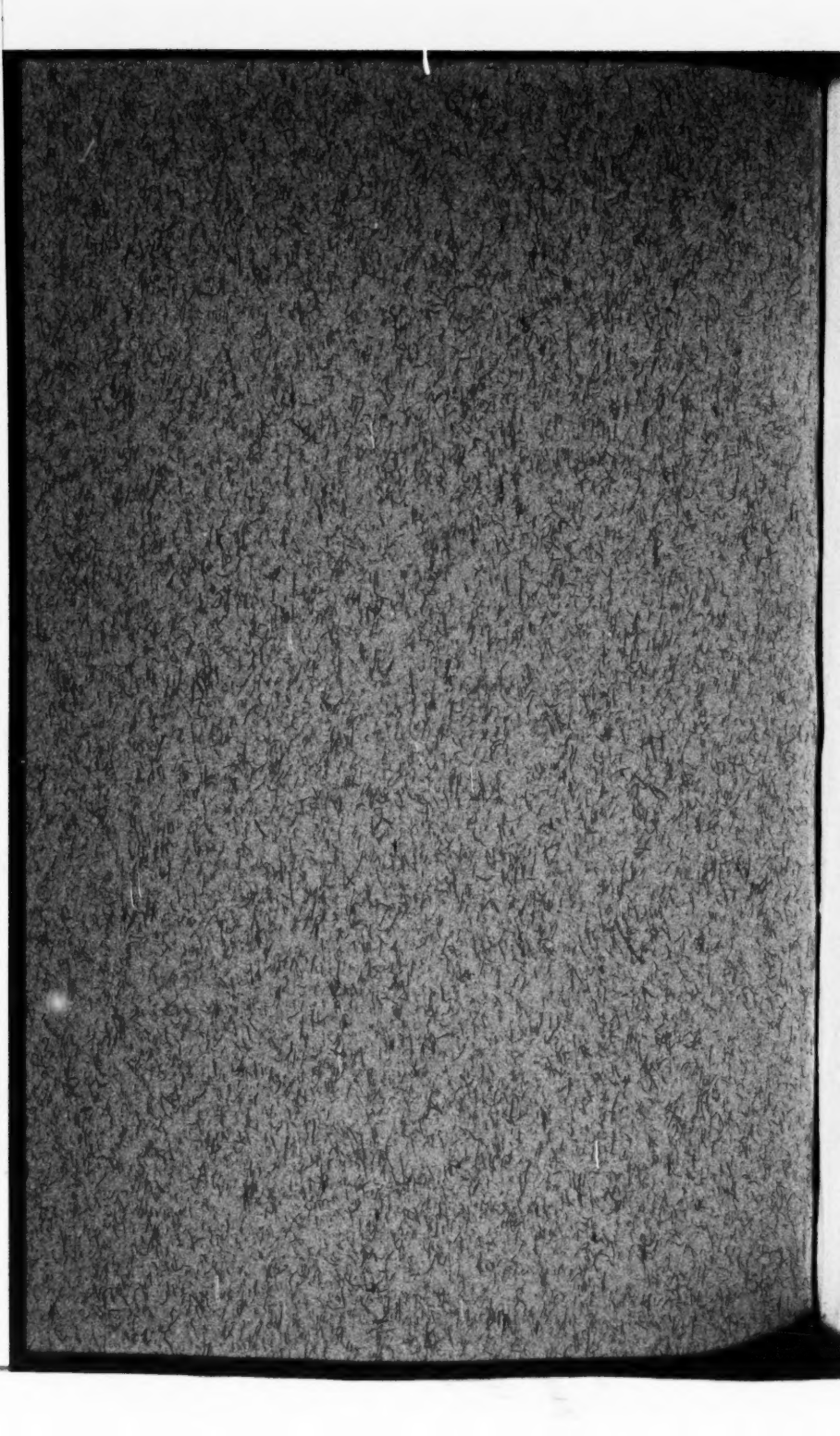

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In the Supreme Court of the United States

OCTOBER TERM, A. D. 1949.

No. 730.

E. B. KAISER COMPANY,
Petitioner,

v.

THE RIC-WIL COMPANY,
Respondent.

BRIEF OF RESPONDENT

In Opposition to Petition for Writ of Certiorari.

STATEMENT OF THE CASE.

The introductory paragraph of the Petition for Writ of Certiorari (page 1) and the first paragraph of Petitioner's "Summary and Statement of Matter Involved" (page 2) are substantially correct, but at this point in the Petition all attempt at accuracy ends.

Starting with the next paragraph the Petition (and the annexed Brief in its support) becomes a mere jumble of Petitioner's opinions which are substituted for actual facts, of distortions created by lifting fragments of the record out of context, and of totally unjustified conclusions jumped to from these unwarranted premises.

SOME UNWARRANTED PREMISES.

High amongst the substitutions of Petitioner's opinion for actual facts are the various holdings which it attributes to the District Court and to the Circuit Court of Appeals.

A comparison of the "holdings" which Petitioner attempts to put in the mouths of these two Courts with the decisions which they actually rendered shows only the

most superficial resemblance. It indicates clearly Petitioner's inability to base even a plausible sounding Petition upon the true decisions of the Courts below, and shows that its entire request for certiorari is merely a frivolity and a sham.

"THE QUESTIONS PRESENTED."

Specifically, neither Court made any holding having the meaning inferred by **any one** of the three "Questions Presented" (Petition, p. 6).

1. The Circuit Court of Appeals for the Seventh Circuit did **not** hold "that prior art patents **which disclosed the patented thing**" cannot invalidate "without clear and convincing testimony," although Petitioner so stated in the first "Question Presented." (Emphasis ours throughout, unless otherwise stated.)

2. The decision of the Circuit Court of Appeals for the Seventh Circuit did **not** deal with any attempt to "repudiate construction" of a claim (Second "Question Presented"), but on the contrary, it affirmed the finding of fact of the District Court holding that Petitioner's device comes within the actual words adopted in the Patent Office (Finding 15, Rec. p. 313).

3. The decision of the Circuit Court of Appeals for the Seventh Circuit did **not** approve "the redrafting of a claim by disclaimer" as suggested by the third "reason relied on for allowance of the Writ" (Petition, p. 6).

Nor are "The Questions Presented" at all aided or improved by the three "Specifications of Errors" (petitioner's Brief, p. 16) which appears to be an attempt to rephrase these questions, and is further discussed later.

On the other hand, much of the argument presented in the Petition and accompanying Brief is based upon matter which was not presented before the District Court and Circuit Court of Appeals at all, as will be more fully pointed out hereinafter.

PETITION FAILS TO SHOW ANY GROUND FOR CERTIORARI.

Moreover, the Petition fails to comply with Rule 38 of the Rules of the Supreme Court of the United States, *first*: in that the accompanying Brief is not direct and concise as required by Paragraph 2 of this Rule, and *second*: in that the subject matter which it attempts to present is merely the ordinary questions of validity and infringement, based on conventional grounds such as paper prior art, which are found in every infringement suit; and hence, the case is not one coming within Paragraph 5 of the Rule "where there are special and important reasons therefor."

Obviously, the subject matter does not come within subparagraph (a) of paragraph 5 of Rule 38, as there is no Federal question decided by a State Court involved.

Clearly, also, it does not come within paragraph (b) relating to conflicting decisions of two different Circuit Courts of Appeals.

And clearly, also it does not come within paragraph (c) relating to the U. S. Circuit Court of Appeals for the District of Columbia.

All that the Petition alleges is that the Court of Appeals did not give as much weight to the prior art patents and to the proceedings in the Patent Office as Petitioner desires.

SUMMARY OF THE REAL "MATTER INVOLVED."

As above indicated, Petitioner obviously bases its entire Petition upon the fact that the District Court and the Circuit Court of Appeals concurred in finding it guilty of flagrant infringement of Respondent's patents.

It is understandable that Petitioner has found its appropriation of Respondent's inventions profitable and therefore desires to continue its infringement thereof.

ARGUMENT.

Inasmuch as Petitioner has relied solely on a large number of reference patents—135 in all—and the testimony of a single alleged expert witness (which testimony turned out to be extremely unsatisfactory for Petitioner), there is little upon which Petitioner can base its case other than by argument, presenting and rearguing for a third time defenses based on the prior art, together with an alleged file wrapper estoppel or two.

That this is the sole purpose of its Petition becomes evident from the Brief which accompanied its Petition, as well as from the record which has now been presented. In the latter it is significant that Petitioner has included copies of eleven of its 135 reference patents and extracts from the file wrappers of three of the patents in suit.

It is also significant that Petitioner has devoted 13 pages (pages 11-14, 18, 24-27 and 29-32) of the 30 pages of its Brief in support of its Petition to the argument of specific prior art patents which it now claims to be anticipatory of Respondent's patents.

Obviously the Petitioner had every opportunity of presenting all this subject matter in the Court of original jurisdiction.

Some of it was so presented, but much of it was never brought before that Court for consideration, and therefore was not before the Circuit Court of Appeals, and so can not properly be brought for the first time before the Supreme Court.

Obviously, this is an attempt to foist upon the Supreme Court the job of determining the ordinary issues of anticipation and infringement and to waste the Court's time on matter not properly before it upon Writ of Certiorari, and as to which the decision of the Circuit Court of Appeals should be final.

> "Such an *ordinary patent* case, with the *usual issues of invention, breadth of claims,* and *noninfringement,* this

court *will not bring here by certiorari,* unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. We therefore find ourselves mistaken in assuming that an important issue of general patent law, under section 4916, R. S., is here involved. The result is that an order must be entered dismissing the writ of certiorari as improvidently granted, at the costs of the petitioner. Writ dismissed." *Keller et al. v. Adams-Campbell Co., Inc. et al.,* 44 S. Ct. 356 (358) (264 U. S. 314) 1924.

"There is nothing in the lower court's decision on either of the added questions to warrant review here. Whether respondents acquiesced in the infringement and are estopped depends upon the facts. Granting of the writ *would not be warranted merely to review the evidence or inferences drawn from it.* • • •

"Moreover, the decision on that point rests on *concurrent findings.* They are *not to be disturbed* unless plainly without support.

"There is evidence to support them. Nor would the writ be granted to review the questions of *anticipation and invention* that petitioner argues, for as to them there is no conflict between decisions of circuit courts of appeals." *General Talking Pictures Corp. v. Western Electric Co.,* 58 S. Ct. 849 (351) (304 U. S. 175, 546) 1937.

"The issues of fact, contested in a long hearing *are not before us for review.* Petitioner assured us, in support of the petition for certiorari here, that 'there is no factual controversy before this Court' and 'we assume the findings of the District Court. Our challenge is directed only to the legal import of these unchallenged facts.'

"Much of petitioner's argument seems to depart from these assumptions and to *invite us to reach conclusions from the voluminous record* in the case, *contrary to those reached by the two courts below.* This we cannot do.

"A seasoned and wise rule of this Court makes concurrent findings of two courts below final here in the absence of very exceptional showing of error." *Com-*

stock v. Group of Institutional Investors, 68 S. Ct. 1454 (1456) (335 U. S. 211) 1948.

"This writ must be dismissed. The petition therefor stated that the cause involved a grave question of vital importance to the public, and alleged as special reason for its re-examination that the decree would deprive petitioner of property without due process of law and of freedom to contract, contrary to the federal Constitution. * * *.

"(1) The argument developed that the controverted *question was whether the evidence sufficed* to establish actual dedication of petitioner's property to public use—primarily a question of fact. That is not the ground upon which we granted the petition, and, if sufficiently developed, would not have moved us thereto." *Southern Power Co. v. North Carolina Public Service Co. et al.,* 44 Sup. Ct. 164 (165) (263 U. S. 508) 1924.

PETITIONER'S FURTHER ATTEMPTS TO MISLEAD THE COURT.

As a basis for this attempt, as above suggested, Petitioner has allowed its imagination to run rampant and has substituted its opinion for the actual facts, some examples showing the extent to which it has departed from the real facts follow:

In the second paragraph of Petitioner's Summary and Statement of Matter Involved (page 2), it is stated, "This is **not** a case in which courts below concurred in **finding significant differences** between the prior art and the patents in suit. Neither Court **recognized any differences** between the prior patent art and the patents in suit."

But what did the Circuit Court of Appeals for the Seventh Circuit say about significant differences?

Chief Judge Major stated (Record, pp. 380 and 381):

"That the disclosure *represented marked advancement* in the construction and insulation of a steam heating system can *hardly be doubted from this record.*

Here *for the first time* was a unit which could be completed indoors, affording workers protection in all kinds of weather and thus *increasing their efficiency,* and insuring a *better quality* product. It was capable of being transported complete, lowered into a trench substantially no larger than sufficient to receive it, could be coupled with other units quickly and accurately in which the joints could be tested and inspected immediately after they had been made, and the trench could at once be filled. The required *depth* of the trench *was also decreased* because of the metal covering employed, which enabled the conduit to *resist heavy loads and shock.* The designed structure *obviated* the necessity of keeping the trench open while the lower half of the shell was being laid and until the cement or concrete used in its construction had set—generally several days—and then keeping it open while the pipe was laid in the bottom portion of the shell and heating insulating material applied to it, and, further, keeping the trench open while the upper half of the shell was completed and waiting until that part of the shell had an opportunity to set.

"It thus became possible not only to dig a *smaller* trench but *immediately to follow* by laying units as fast as there was space prepared for them, to connect and test these as they were laid, and to refill the trench immediately as the connections were made. After installation, the strength of the "Unit-Type" *eliminated breakage* such as had occurred with the "Tunnel-Type" of construction, and if for any reason a section needed to be replaced the old section was as *readily removable* as it was installable so that *maintenance costs were reduced* both by cutting down on breakage and a saving in labor. There is **undisputed evidence** in the record that the "Unit-Type" structure **reduced** the amount of earth which had to be excavated **to 38% of what had formerly been required,** that it **eliminated substantially all breakage,** permitted installations **without interruption of traffic,** and **increased by four times the speed** with which conduits could be laid. And it was shown that the "Unit-Type" conduit of the patents in suit has largely taken the place of the older "Tunnel-

> Type." The former type represents some 85% of plaintiff's business and 100% of defendant's business. Plaintiff manufactured 4,500,000 feet (852 miles) of "Unit-Type" construction in about seven years."

How can the Petitioner have the temerity to come before the Supreme Court and attempt to tell it that these advantages recognized by the Seventh Circuit Court of Appeals are not "significant differences"?

Further in the same paragraph (Petition, p. 2) Petitioner says, "Neither Court analyzed or **discussed** a single prior art patent * * *."

In the Judgment of Judge Igoe of the District Court (Record, pp. 317, 318) more than **three dozen of the prior art patents are specifically referred to,** and it is pointed out that they do not anticipate the patents in suit. Can this be considered anything short of discussion?

In the paragraph in Petitioner's Summary and Statement of Matter Involved (starting on page 2 thereof and continuing over onto page 3) appears the following: "This is **not** a case where the Courts below concurred in finding that the patentee **had not shifted his position** from that upon the basis of which his patent was granted; nor is it a case in which the Courts below concurred in justifying the patentee's shift of position."

This, as is apparent from succeeding portions of the Petition and Brief, is based upon Petitioner's erroneous and unwarranted contention that Respondent had attempted to read out of patent 2,050,968 the words "flat plate" as descriptive of the spacer claimed in this patent, the Petitioner saying on the succeeding page (p. 4): "The accused structure of Petitioner is a three-legged spider and **not a 'flat plate.'** * * * The Court of Appeals in its opinion did not discuss this issue."

There are two separate and deliberate attempts to mislead the Court in the single slight quotation above; **first**; in the allegation that the accused structure is **not a flat plate.**

The contrary was proven and appears definitely in Finding 15 of the District Court as follows:

> "15. The **defendant's** spacer is a **flat piece of metal** having a notched periphery, and **is a 'plate'** in the sense in which the word 'plate' is used in patent No. 2,050,968." (Record p. 313.)

Second; not only is this finding quoted by the Circuit Court of Appeals in its Opinion (Record p. 386), but a few lines later on Chief Judge Major says:

> "Having concluded that these findings are not clearly erroneous, or to put it another way that they are substantially supported by the record, we find no occasion to *discuss further* the question of validity or infringement. That conclusion follows from the findings."

showing clearly that Petitioner's flat plate was expressly considered and discussed to the extent the Court deemed necessary.

Thus, as previously suggested, it becomes apparent that the alleged "Matter Involved" upon which Petitioner has based its "Questions Presented" is very largely a figment of its imagination, and that any inferences drawn therefrom are correspondingly inaccurate.

PETITION BASED ON MATTER NOT PREVIOUSLY PLEADED.

Another way in which the Petitioner has attempted to mislead the Supreme Court and to cast aspersions on the Circuit Court of Appeals and District Court, is by accusing these two Courts of having disregarded prior art patents which Petitioner **now** urges as anticipatory of certain of the patents in suit, but which **were not produced for this purpose.**

For example, starting on page 11 of Petitioner's Brief and continuing to page 14 thereof, again being resumed on page 18 of the Brief, much ado is made over the patent to

Ashcroft 235,846, Petitioner implying that the District Court and Circuit Court of Appeals were relict in not holding this to be an anticipation of Gottwald patent 1,991,455. Petitioner has craftily avoided the use of the word "anticipation" but the implication is unavoidable, as in the above mentioned pages it says:

> "Thus Ashcroft showed *each of the elements* of claim 11 of the Gottwald patent * * *.
>
> "Ashcroft also *disclosed the idea* of prefabricating the insulated pipe in section * * * (page 13).
>
> "Thus Ashcroft disclosed an insulated pipe *fully meeting* what Gottwald claimed as his in the Patent Office * * * (page 14).
>
> "The Ashcroft patent, which was published 50 years before Gottwald applied for his patent, *showed everything* claimed, responding literally and in substance. (See pp. 11 to 14 herein)." (page 18.)

But what was Ashcroft cited for?

This is shown clearly by the Bill of Particulars (starting Record p. 29) and the Amendment to the Bill of Particulars (Record p. 45), the number of this patent **appearing only** in the Bill of Particulars on pages 29 and 30 and showing that it was cited "as to the same aforesaid patent (1,991,455) the following patents are cited **as illustrative of the prior art**" and in the second instance, "as to the aforesaid patent (2,050,968) the following patents are cited **as illustrative of the prior art.**" In each instance the group of patents said to be merely illustrative of the prior art is preceded by a group stated to be "cited as anticipation."

In the 35 pages of testimony of Petitioner's witness Kellogg in regard to Gottwald patent 1,991,455 (appearing on Record pp. 172-179, 184-210), this witness discussed nine prior art patents but never made a single mention of the Ashcroft patent.

It was **not** urged by Petitioner as **anticipating any patent!**

Certainly, when this patent was presented to the District Judge it was produced solely as illustrating the prior art, and was not considered to be anticipatory in any way.

Now should the Court be subjected to criticism for not having discussed it from the standpoint of anticipation?

And certainly the Circuit Court of Appeals, not having before it the question of whether the patent anticipated, likewise should not now be criticized for not going into this matter in detail (or at all).

> "On oral argument and submission of the cause it appears that although petitioner by its amended answer alleged generally that respondents 'do not come into * * * court with clean hands,' the *answer made no mention* of the restrictions contained in the license agreement. *The District Court made no findings* of fact or law with respect to them. On appeal to the Circuit Court of Appeals *petitioner assigned no error* with reference to them and the Circuit Court of Appeals *did not consider them,* saying: 'We affirm the judgments of the District Court, considering here only the appellant's claim of error.'
>
> "Thus the *only question* for which we granted certiorari *is one not properly raised, litigated or passed upon below.* * * * The grounds asserted for the allowance of certiorari are inadequately supported by the record, and the writ is therefore dismissed." *McCullough v. Kammerer Corp. et al.,* 65 S. Ct. 297. (323 U. S. 327.) 1945.

Petitioner (on page 18 of its Brief) also refers to the patent to Bartlett 417,768, and likewise implies that this should have been held an anticipation of Gottwald patent 1,991,455.

The Bill of Particulars and its Amendment show that this patent **was not cited** against the Gottwald patent, **even as illustrative** of the prior art, but that its number is mentioned only on page 30 of the Record, where it was mentioned among those alleged to be **illustrative of the prior art** applicable to a totally **different patent, No. 2,050,968.**

In the above mentioned 35 pages of the record relating to testimony of the witness Kellogg, absolutely no reference is made to the Bartlett patent.

Again, Petitioner states in its Brief (p. 24),

> "In finding this patent (McLeish patent Re. 22,988) valid, neither Court analyzed the Steffens Patent No. 1,227,087 (R. 432) believing such analysis unnecessary and 'futile' without testimony."

Referring again to the Bill of Particulars, the Steffens patent number **appears only** on Record page 30, among the group of patents cited against **Gottwald and McLeish patent No. 2,050,968, not** against the **McLeish** patent **at all**, and even there was alleged to be illustrative of the prior art only. It was **never** cited against **either the reissue** patent **or the original** on which the reissue was based.

Illustrations of Petitioner's spacing plate and the "spider" of Elkin patent No. 1,041,256 appear on page 29 of Petitioner's Brief, together with considerable argument as to the applicability of this Elkin patent to Gottwald and McLeish patent 2,050,968.

Elkin was cited in the Bill of Particulars in only one spot on page 29, among the group of patents said to be cited as **illustrative of the prior art** in regard to **Gottwald patent 1,991,455**, and thus was **not cited** for **any purpose** in **conjunction with the patent** to which Petitioner now attempts to apply the same.

In addition to **not** having been **submitted to the District Court** for the purposes now argued, **not one of these four prior art patents was mentioned** in Petitioner's "Statement of points upon which Defendant-Appellant intends to rely on Appeal" (pp. 323-326).

We submit that it is not only unreasonable to expect the District Court and Circuit Court of Appeals to have discussed matters which were not properly brought before them, but that the attempt to castigate these Courts for their alleged failure in this regard is unfair to them in the

extreme, and is a patent attempt to misrepresent them to the Supreme Court.

LIKE ITS "QUESTIONS," PETITIONER'S "SPECIFICATION OF ERRORS" MISREPRESENTS FACTS.

The Petitioner's three "questions" are, in different verbiage, included as its Specification of Errors (Brief, p. 16), and in each instance it will be apparent that Petitioner has unconscionably distorted the statements of Chief Judge Major in making its Specification.

Specification 1. "The Court of Appeals erred in holding a patent **cannot be invalidated by self proving prior art** itself, unsupported by testimony." **No such statement appears** in the Court's Opinion (Record pp. 377-388), but the decision **does** say (Record p. 383): "The defendant's reliance upon the prior art to invalidate the claims in suit we think placed upon it the **burden of overcoming the presumption which accompanied their allowance.**"

This, it will be seen, is quite a different matter from the alleged error specified.

While neither Court made any general finding that oral testimony was required or could have helped the prior art, had they done so, they would have been within their prerogative. As indicated by the Circuit Court of Appeals, "If 135 such patents are required to show the state of the prior art, it must have been in an **uncertain and highly confused state.**" (Record p. 382.) That the need for testimony in such case is to be determined by the trial judge is well illustrated in one of the decisions cited by the Petitioner:

> "Now the question whether the judge needs the assistance of experts to understand the specifications *is for him to decide.* Doubtless he ought to be chary of assuming too readily that he does understand what he may not; but, if he is too confident, his mistake eventually transpires. *The important point is that it*

is he who must determine when he needs the help of experts and when he does not, and that decision, except in the clearest case, we should not be disposed to disturb." *Kohn v. Eimer et al.*, 265 F. 900 (902) (C. C. A. 2, 1920).

It will be noted that where Petitioner cites this decision (Brief, pp. 20, 21), it very specifically fails to quote any of its language, but applies only to Petitioner's own interpretation to the citation.

In this connection, the Circuit Court of Appeals continued in discussing the unsatisfactory character of the testimony which was submitted on Petitioner's behalf, and including Petitioner's references to paragraphs 8 and 9 of the District Court's Judgment, as immediately following the above quotation from Chief Judge Major's Opinion we find:

> "We doubt, however, the soundness of the statement in paragraph 9 that defendant's expert witness Kellogg was not qualified to testify either as to the legal effect or the engineering aspects of patents because he was not a member of the bar or a registered professional engineer. We think that such handicap *would go to the weight or credit* to be attached to his testimony rather than his qualification. **It is difficult to discern,** however, **how defendant was harmed** by the statement complained of, because *the fact is that this witness was* not disqualified to testify but *was permitted to do so in detail* concerning the claims in suit, as well as the prior art patents, and that *the court considered and weighed such testimony.* As a result the court found, 'The testimony of the witness Kellogg is not consistent within itself, and is contradictory to an established fact,' that 'The testimony of the witness Kellogg is not corroborated in any respect,' and that 'The testimony of the witness Kellogg is *so lacking in credibility as to be of substantially no weight.*'
>
> "*We have read all the testimony in the record,* including that of the witness Kellogg and *we thoroughly agree with the manner in which the court characterized his testimony.* He was permitted to take the claims in

suit one by one, compare them with prior art patents many of which had long since expired, and to state that they were a direct anticipation of the claim concerning which he was testifying. He was an avid witness and his testimony reads as though it was a biased argument rather than a statement of facts. He was much too good an expert in that he extolled the virtues of the prior art, much if not all of which had never been put to use, and deprecated the patents in suit which had been put to extensive use, to such an extreme extent that his *testimony carries no conviction.*" (Record pp. 383, 384.)

And what did the Courts do in regard to the voluminous prior art (135 patents)?

(1) Judgment (Record pp. 317, 318):

"4. That Letters Patent No. 1,991,455 marked a distinct advance in the construction of conduit systems by providing units, each consisting of an inner pipe, a covering load sustaining shell and heat insulating material, which construction overcame difficulties which had existed in prior structures for many years and has gone into wide use and largely displaced such prior structures; that this patent is not anticipated by the references cited against it, particularly, *Reimann,* 903,316; *Durant,* 1,709,844; *O'Hara,* 129,968; *Holden,* 732,209; *Loughman,* 809,963; *Widiger,* 1,459,126; *Trucano,* 1,140,633; *Farley,* 701,999; *Powell,* 1,797,443; *Lamson,* 1,122,130; *Lawrence,* 1,853,736; that this patent is good and valid at law, is of a pioneer character and is entitled to a liberal interpretation, and that defendant has infringed each of claims 11, 14, 15, 16 and 17 thereof.

"5. That Letters Patent No. 2,050,968 disclosing a spacer axially movable in a conduit shell and holding a pipe therein against motion toward the top or sides of the shell discloses invention, is not anticipated by the patents cited by defendant there against, particularly, *Babcock,* 1,368,013; *Lamson,* 1,122,130; *Elkin,* 1,041,256; *Giachetti,* 1,995,473, *Bartlett,* 417,768; *Hurst,* 462,047; *Aldrich,* 289,744; *Newton,* 241,404; *Emery,* 253,917; *Harvey,* 534,473; *Trucano,* 1,140,633;

Sherwood, 951,342; *Timby,* 379,744; *Aylsworth et al.,* 869,768; that patent 2,050,968 is good and valid at law, and that the defendant has infringed claim 2 thereof.

"6. That Letters Patent 2,378,214 is the first disclosure of an integral expansion device comprising a flat U-shaped bend of conduit pipe enclosed in a T-shaped casing and having heat insulating material between the pipe and casing; that this patent discloses invention, is not anticipated by the patents cited against it, particularly, *Holly,* 9,821; *Osborne,* 236,247; *Shepler,* 394,620; *Davis,* 231,479; *Schmidt,* 700,378; *Brown,* 1,495,066; *Latimer,* 1,466,054; *Kaeferle,* 330,221; *Feigen,* 1,440,978; *Ballantyne,* 1,703,605; *Reimann,* 803,316; *Farley,* 701,999; and is good and valid at law; and that the defendant has infringed each of claims 1, 5 and 6 thereof.

"7. That Reissue Patent No. Re. 22,988 discloses a new and useful invention in an anchor passing through a conduit shell to transmit forces from a pipe within the shell to the ground; that the patent is not anticipated by the patents cited against it by the defendant, particularly, *Babcock,* 1,368,013; *Cumpfer,* 1,481,255; *Dennis,* 2,209,325; *Rateau,* 751,998; that this patent is good and valid at law; and that the defendant's anchors, both round and square, infringe claim 1 thereof."

Surely this shows consideration of the patents by the District Court!

(2) Opinion by Chief Judge Major:

"*It was shown* that for many years central heating systems had been used but that their use was much restricted * * *" (Record p. 379.)

"Third, *it is shown* that the problem which confronted the central heating industry *was first solved* by the disclosures of the patent in suit *or,* at any rate, *its progress was immeasurably advanced* over anything which had been before relied upon. It has been held that prior art patents under these circumstances *do not anticipate.* * * * Fourth, we have already made reference to the excessive number of prior art patents offered by the defendant. *If 135 such patents are re-*

quired to show the state of the prior art, *it must have been in a highly uncertain and confused state.* And it has been held that the excessive number of such references *is in itself persuasive* of the *futility of prior attempts* to solve the problem. * * * (Record pp. 381, 382.)

"The defendant's reliance upon the prior art to invalidate the claims in suit we think placed upon it the *burden of overcoming the presumption* which accompanied their allowance. * * * (Record p. 383.)

"A study of the record is convincing that the trial judge was not only keenly alert to the issues for trial and decision but that *he gave the defendant every opportunity to show that the claims in suit were invalid.* In fact, he allowed defendant's so-called expert witness *almost unlimited latitude* in expressing his opinion upon various issues which were before the court for decision." (Record p. 385.)

Petitioner accuses the Court of failing to do various things merely because the Court has not specifically stated that it had done them, and in the entire absence of any authority for assuming that the Court had not done what is required of it.

For example, Petitioner's Brief (p. 33):

"The Courts below, *in declining to read* and in characterizing as mere 'argument' the reading by counsel (R. 384), seriously erred."

The page of the record referred to in this connection (Record p. 384) **does not say** that the Court **had declined to read**, but **does** say:

"We have carefully *considered* this argument, especially as it pertains to the prior art patents. * * *"

If this be not a statement that the Court **had** read the patents, it certainly is far from a statement that it **had not** read them.

As in *U. S. v. Chemical Foundation, Inc.*, 47 S. Ct. 1 (6) (272 U. S. 1), 1926:

"The presumption of regularity supports the official acts of public officers and, *in the absence of clear*

evidence to the contrary, courts presume that they have properly discharged their official duties."

Specification 2. "The Court of Appeals erred in construing patent claims without reference to the construction placed upon the claims by the applicant and the Patent Office when the patent was allowed" (Brief, p. 16).

Can Petitioner claim that its spacer is not a flat plate and that it consequently does not infringe a claim for a spacer comprising a flat plate? If anything, this is merely contradicting both the District Court and the Circuit Court of Appeals, because it is an absolute denial of Finding 15, above mentioned, that "defendant's spacer **is a flat piece of metal** having a notched periphery, **and is a 'plate'** in the sense in which the word 'plate' is used in patent No. 2,050,968" (Record, p. 386).

In other words, this specification is merely an attempt to ask the Supreme Court to hold that a flat piece of metal, which both Courts have held to be a plate, is not a plate.

Certainly it is no basis for the alleged error, as there has been **no change in construction** of the word "plate."

Specification 3. "The Court of Appeals erred in approving the redrafting of a claim by disclaimer and in not requiring that the subject matter disclaimed be patentably distinct from subject matter retained" (Brief, p. 16).

Petitioner has never before urged the differentiation it seems to be trying to make in this paragraph. Although this specification is somewhat confused and ambiguous, as it apparently is intended to correspond to "Question 3" appearing on page 6 of the Petition, it seems to be an attack upon the disclaimer statute based upon some feeling that restriction of a claim should be made only by "risking surrender and reissue" or upon Petitioner's attempt to confuse claim 11 with claim 12 of this patent (Petitioner's Brief, pp. 33-37).

As to the latter, it is probably sufficient to point out that claim 12 is so different from claim 11 that it was not even in issue, and that neither party and neither Court has ever suggested that it could be infringed by Petitioner's structure, while claim 11 not only was held to be infringed by both Courts but was, at least for a limited time, admitted to be infringed by Petitioner's own witness.

No question of the disclaimer was pleaded in the District Court or **properly presented in either Court below**, as clearly indicated by the Answer (Record pp. 7 to 13) and the Amendment thereto (Record pp. 22-24), in neither of which the word "disclaimer" or anything of like import appears.

As to the theory that "a patent owner filing a statutory disclaimer" is "thereby admitting invalidity of the claim as issued" (Record p. 6) which underlies Question 3 and Specification 3, this theory is, of course, just another of petitioner's substitutions of its opinion for the actual facts, as it is well established that a disclaimer has absolutely no such effect.

> "Much of the defendant's argument depends upon an *illegitimate inference from the disclaimer*; that is, that it *conclusively concedes* all the disclosure to have been in prior art except the regulation of the bath after it was formed." *United Chromium, Inc. v. International Silver Co.*, 60 F. (2d) 913 (C. C. A. 2, 1932).
>
> "His disclaimer *does not have the effect of conceding* that what was disclaimed is, in fact, in the prior art. A patentee need not, at his peril, claim all that he might." (*Sales Affiliates, Inc. v. Hutzler Bros Co., Same v. Carter Products, Inc.*, 71 F. Supp. 287 (300) (D. C., D. Md., 1947).
>
> "We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully

met and defeated, a disclaimer will not affect the real value of his patent, and to make it will save trouble and expense and do no harm. *We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect* of the other matter; and it has been so held." *Permutit Co. v. Wadham et al.*, 13 F. (2d) 454 (457) (C. C. A. 6, 1926).

IN CONCLUSION.

From the above it is apparent that the Petition presents three questions, none of which is based on the decision of the Circuit Court of Appeals for the Seventh Circuit.

The questions amount merely to the usual issues of validity and infringement, and do not present special or important reasons such as are necessary to warrant the issue of Certiorari.

Petitioner shows clearly that it seeks to re-litigate the facts on which there were concurrent findings against it in both Courts below, and has failed to show any exceptional error, and in fact has shown no error.

The Petition attempts to raise questions which were not properly raised, litigated or passed upon in the Courts below.

For these reasons it is respectfully submitted that there is no reason whatsoever for the issue of the Writ of Certiorari and that the Petition should be dismissed forthwith.

Respectfully submitted,

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